

CAW 3634



PATENT APPLICATION
ATTORNEY DOCKET
NO. 68410

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Siegler et al.
Application No.: 09/547,563
Title: JACK SHAFT GARAGE DOOR OPERATOR
Filed: April 12, 2000
Group Art Unit: 3634
Examiner: Cohen, C.

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on this date.

10/12/01
Date

Steven G. Parmelee
Registration No. 28,790
Attorney for Applicant(s)

#5 response
10-22-01

RESPONSE

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TO 3600 MAIL ROOM

Honorable Commissioner of Patents
and Trademarks
Attention: Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

1. In an Office Action dated August 22nd, 2001 (paper No. 4) as entered in the above captioned matter, claims 5 through 16 were rejected as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. This rejection is respectfully traversed.

2. Claims 5 through 16 were rejected as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. In particular, the examiner quoted from *Ball Corporation vs. United States* as follows:

"The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application."

The examiner argues that the two new independent claims constitute an improper recapture because those claims replace pre-existing "means for preventing" language with a portion of the elements recited in the specification that are encompassed by such means. The examiner argues that, in the original application, the applicant persuaded the examiner that the claims including such means were allowable over the prior art and that such persuasion triggers the recapture rule. The examiner also argues that by now presenting this limitation in non-means plus function language, the recited structure no longer includes any equivalent structure and hence appears to be narrowed rather than broadened.